

REMARKS

Applicant respectfully requests reconsideration of the instant application in the view of the foregoing amendments and the following remarks. Claims 1-2, 4-10, and 12-34 are *pending*. Claims 1, 33-34 are *independent*. Claims 3 and 11 were previously cancelled. Claims 1, 15-16, 27, 30, and 33-34 have been *amended* herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicant submits that the originally filed claims are patentable and reserve the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification, figures, claims, and abstract and that no new matter has been added by way of these amendments.

Priority Objection

The Examiner on page 2 of the Office Action asserts that Applicant has not compiled with one or more conditions for receiving benefit of an earlier filing date under USC 119(e). Applicant respectfully traverses this objection. Applicant submits that this patent application was recently transferred in from another firm. Applicant is currently investigating the priority date of the application and will respond to the Examiner's objection in due course.

Double Patenting Rejection

Claims 1, 33, and 34 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 32, 33, and 34 of copending Application no. 10/633,080, and claims 1, 10, 20, and 21 of copending Application no. 10/456,000, and claims 1, 12, 17, and 21 of copending Application no. 10/464,601. Applicant

provisionally traverses the provisional statutory double-patenting rejection and submits that a Terminal Disclaimer may be filed if deemed to be required when the pending applications issue.

Claim Rejections - 35 U.S.C. § 101

The Office Action has rejected claims 1-2, 4-10, and 12-34 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant respectfully traverses this rejection. Applicant submits that there is no test for non-statutory subject matter that subjectively precludes the aforementioned claims. MPEP §2106, Section IV, states "claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection." MPEP §2106 also discusses "[w]hile abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be."

Applicant submits that the elements recited in noted claims are, in fact, directed to statutory subject matter and do not fall within the recognized Judicial Exceptions as merely abstract ideas (such as mathematical algorithms), natural phenomena, and/or laws of nature.

Though Applicant respectfully traverses the Examiner's rejection and reserves the right to argue patentability of the claims in their original form at a later time, Applicant has amended independent claim 33 to provide clarification and/or to better track business practices. Claim 33 is a "computerized system for managing Risk" and recites "a memory" and "a processor disposed in communication with said memory, and configured to issue a plurality of processing instructions stored in the memory, wherein the processor issues instructions to...". Amended claim 1 recites, inter alia, a "processor implemented method" and "associating by a processor..." and claim 34 recites, inter alia, a "processor-

readable medium storing" and "generate by a processor..." Applicant submits claims 2, 4-10, and 12-32, which depend directly or indirectly from independent claim 1, are directed to statutory subject matter for at least the reasons discussed above. Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific explanation describing how claims 1, 33-34 are allegedly directed to non statutory subject matter.

Applicant submits that support for the amendments may be found throughout the originally filed specification, abstract, drawings, and claims, and that no new matter has been added by way of this amendment. Accordingly, for at least these reasons, Applicant submits that claims 1-2, 4-10, and 12-34 are directed to statutory subject matter and withdrawal of this ground of rejections is requested.

Claim Rejections 35 USC § 103

Claims 1-2, 4-5, 7, 9, 13-14, 18-28, and 30-34 are rejected under 35 U.S.C. 103(a) as being patentable over Tengal (U.S. Patent No. 5,940,812) (hereinafter "Tengal") in view of Dave Berns' article, Resort Owners Seek Loans, Los Vegas Review Journal, Nov 16, 1999, pg. 1.D (hereinafter "Berns"). Claims 6, 8, 10, 12, and 15 are rejected under 35 U.S.C. 103(a) as being patentable over Tengal in view of Berns in further view of *Casino Gambling in New Jersey - A Report to the National Gambling Impact Study Commission*, New Jersey Casino Control Commission, (January 1998) (hereinafter "NJCCC"). Claim 16 is rejected under 35 U.S.C. 103(a) as being patentable over Tengal in view of Berns in further view of Capitol Briefs, Arizona Daily Star, Feb 5, 1997, pg 3.B. (hereinafter "Briefs"). Claim 17 is rejected under 35 U.S.C. 103(a) as being patentable over Tengal in view of Berns in further view of FTC Settles with Debt Collection Agency, Credit Risk Management Reporter, Sep 5, 2000, vol 10, Iss 17, pg 1 (hereinafter "FTC"). Applicant respectfully traverses these rejections.

Claim 29 is rejected under 35 U.S.C. 103(a) as being patentable over Tengal in view of Berns in further view of Official Notice. Applicant respectfully traverses the Examiner's use of official notice in the rejection of claim 29 as well as any other instances in the Office Action. Should the Examiner disagree and maintain his position, Applicant explicitly requests documentary support, as required by the MPEP, that the elements in claim 29 would have been well known to one of the ordinary skill in the art, at the time of the invention within the context of the recited claimed elements.

Applicant further submits that a *prima facie* case of obviousness has not been established and that the pending claims are patentably distinct from the cited references, taken alone or in combination. MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants submit that the rejections in the pending Office Action do not establish each of these requirements. MPEP § 2142 provides that, "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

Applicant contends that a *prima facie* case of obviousness has not been established, for reasons discussed below, but has provided the following discussion in an effort to provide clarification of the claim elements, expedite further prosecution, and to more accurately track Applicant's current practices.

Claim 1 recites, inter alia "generating a risk quotient comprising a quantitative value of an amount of Gaming Industry related Risk, wherein calculating the risk quotient criteria comprises a value determined..." The Office Action has cited col. 6, lines 46-61 of Tengal in rejecting claim 1, specifically equating these elements to an "overall weighted score." (Office Action, September 18, 2008, page 8).

However, Tengal simply discusses matching a best available loan to a potential borrower via a telecommunications system. More specifically, Applicant submits that the cited sections of Tengal merely discuss that lenders may specify loan acceptance criteria by defining requirements for elements for the loan acceptance criteria. As an example, one of the cited portions of Tengal, relied on by the Examiner, states that "lenders may assign weighting factors to any or all of the elements making up the loan acceptance criteria and define an overall weighted score the potential borrower must satisfy." (Tengal, col. 6, lines 48-51). At best, Tengal discusses criterion for extending a loan to a borrower where the criteria are assigned different weights. However, Tengal has no ability of "generating a risk quotient comprising a quantitative value of an amount of Gaming Industry related Risk..." As such, Tengal's reference to specifying loan acceptance criteria is fundamentally different than the claimed "generating a risk quotient comprising a quantitative value of an amount of Gaming Industry related Risk, wherein calculating the risk quotient criteria comprises a value determined..." as recited in claim 1. Applicant submits that Berns, an article discussing a financially failing resort, does not remedy this deficiency in Tengal with regard to independent claim 1. As such, Applicant respectfully submits that independent claim 1 is distinct and patentable over the applied references of Tengal and Berns, alone or in combination, for at least the reasons given above.

Further, the Office Action on page 4 acknowledges that Tengal does not teach "indicating in a computer system that a risk subject is a Gaming Industry entity according to the entity's status comprising at least one of: a provider of gambling activities, a gambling facility, a gambling facility operator, an employee of a gambling facility operator, and a provider of services outsourced from a gambling facility operator." The Office Action has cited Berns to cure this deficiency in Tengal as allegedly showing "the application of the invention to the Gaming Industry" where "the Resort operates a casino and is seeking loan." (Office Action, September 18, 2008, page 10). Further, the Office Action alleges that it "would have been [allegedly] obvious to one having ordinary skill in the art at the time of the Applicant's invention to have provided Tengal with the teaching that the Gaming Industry seeks loans in order to have provided Gaming Industry with a means to..." (Office Action, September 18, 2008, page 10).

Applicant respectfully disagrees. Berns is simply an article discussing a 4-month-old Resort not generating enough cash flow to meet payments on its publicly traded bonds and other debts forcing operators to seek additional loans to refinance the property. Bern's general discussion of refinancing a resort's loan does not disclose or suggest "indicating **in a computer system that a risk subject is a Gaming Industry entity** according to the entity's status comprising at least one of: a provider of gambling activities; a gambling facility; a gambling facility operator; an employee of a gambling facility operator; and a provider of services outsourced from a gambling facility operator" as recited within the context of claim 1. (Emphasis added). Applicant respectfully submits that independent claim 1 is patentable over Berns and Tengal, alone or in combination, for at least these additional reasons.

Moreover, Applicant submits that the Examiner has not provided a rationale for why one of ordinary skill in the art at the time the invention would combine Berns, an article discussing a

financially failing resort, with the teachings of Tengal, that relates to a loan matching method to achieve the claimed invention. The Examiner merely concludes that combination of disparate references result in the claim elements; thereby applying impermissible hindsight. As such the Examiner has failed to establish one of the requirements of MPEP §2141.02 and thus failed to establish a prima facie case of obviousness. If the Examiner maintains this rejection, the Applicant requests clarification as to how one of the ordinary skill in the art would have allegedly combined the cited references to achieve the claimed invention. As such, Applicant respectfully submits that independent claim 1 is patentable over Berns and Tengal, alone or in combination, for at least the above discussed reasons.

Although of different scope than independent claim 1, Applicant submits that independent claims 33 and 34 are patentably distinct from the cited references, taken alone or in combination, for at least similar reasons to those discussed above identifying deficiencies in the cited references with respect to independent claim 1. Furthermore, Applicant submits that claims 2, 4-10, 12-32, which depend directly or indirectly from independent claim 1, are also patentably distinct from the cited references, taken alone or in combination, for at least similar reasons to those deficiencies discussed above in the cited references with respect to independent claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejections for these claims as well.

Conclusion

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-2, 4-10, and 12-34, all: overcome all rejections and/or

objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art and reserves the opportunity to more particularly traverse, remark and distinguish over any such remaining claim elements and/or bases for rejection at a later time should it become necessary. Further, any remarks that were made in response to an Office Action objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Office Action objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209-314CP1. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209-314CP1.

In the event that a telephone conference would facilitate examination of the application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,
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